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REMARKS

Applicants appreciate the Examiner's review of the above-identified patent application and respectfully request reconsideration and allowance in view of the following remarks.

Claims 1, 4-12, 25, and 27-36 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Carney (U.S. Patent 5,784,452). Claims 13-247 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Carney in view of Cambray et al. (U.S. Patent No. 5,381,470). Applicants respectfully traverse these rejections.

Applicants respectfully continue to submit that the Examiner has failed to make a *prima facie* case of obviousness of any of the pending claims. Applicants also respectfully submit that finality of the present Office Action dated May 6, 2003 (hereinafter referred to as the present Office Action) rejecting the pending claims is improper because the Examiner has failed to make a proper rejection of any the pending claims.

Applicants respectfully submit that the Examiner continues to not address Applicants' assertion that the Examiner has failed to make a *prima facie* case of obviousness. In the "Response to Arguments" section of the present Office Action, the Examiner

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states, in conclusory fashion, that Applicants' arguments filed on February 14, 2003 (wherein the Applicants assert that the Examiner has failed to establish the elements of a *prima facie* case of obviousness) have been fully considered but are not persuasive. The Examiner then states that the Applicant's arguments have been addressed in the above claim rejections.

Applicant submits that the Examiner has not addressed the Applicants' arguments. The present Office Action merely reiterates (nearly word-for-word) the prior Office Action. Additionally, the Examiner continues to assert that while the cited references admittedly do not disclose or suggest all the elements recited in the pending claims, that such modifications would be obvious to one skilled in the art without providing any additional support beyond the mere assertions.

In the present Office Action, the Examiner makes no less than twelve separate assertions of facts being well known to those skilled in the art, yet despite Applicants' repeated requests, has yet to include a single citation to prior references or a single affidavit in support of the Examiner's positions.

Applicants again remind the Examiner that MPEP sections 2142-2144 state, in pertinent part:

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Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - §2143.03 for decisions pertinent to each of these criteria. (MPEP 2142, emphasis added).

. . .

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). (MPEP 2143.03, emphasis added).

. . .

With respect to relying upon "official notice," the MPEP provides that "The examiner may take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being 'well known' in the art." (MPEP 2144.03, emphasis added). However, the MPEP also provides that "if the applicant traverses such an assertion the examiner should cite a reference in support of his or her position." (Id.) Moreover, the MPEP provides:

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In re Ahlert, 424 F.2d 1088, 1091, 165 USPQ 418, 420-421 (CCPA 1970) ("[A]ssertions of technical facts in areas of esoteric technology must always be supported by citation of some reference work" and "allegations concerning specific 'knowledge' of the prior art, which might be peculiar to a particular art should also be supported." Furthermore the applicant must be given the opportunity to challenge the correctness of such assertions and allegations. "The facts so noticed serve to 'fill the gaps' which might exist in the evidentiary showing" and should not comprise the principle evidence upon which a rejection is based.) (Id.)

By merely reiterating the claim elements and then stating in conclusory fashion that those elements are "well known," the Examiner has clearly failed to meet the standards for a *prima facie* case of obviousness for all of the rejections of the pending claims. To the extent the Examiner is relying on "common knowledge" in rejecting any of the pending claims, Applicants traverse those claims of common knowledge and calls upon the Examiner to more specifically identify what facts are alleged to be common knowledge and further to provide evidence in support of such alleged common knowledge in the form of a citation to prior art references or in the form of an affidavit. Applicants submit that the cited elements are not well known in the art, let alone

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"notoriously" well known. Moreover, Applicants submit that the Examiner has attempted to take "official notice" of substantial portions of each of the pending claims. This is hardly the kind of *de minimis* gaps in the record for a showing of obviousness that "official notice" is intended to fill.

In addition to the points raised above, the Examiner has also failed to show WHERE in the prior art can be found a "clear suggestion" that the claimed combination is obvious. In *Gillette Co. v. S.C. Johnson & Son, Inc.*, 919 F.2d 720, 16 USPQ2d 1923 (Fed. Cir. 1990) the appellant argued that the district court misapplied the Section 103 nonobviousness standard "by adopting an overly stringent test" that required "that the claimed combination be 'clearly suggested' by the prior art in order to be obvious." 16 USPQ2d at 1926.

The Federal Circuit found no reversible error stating:

"[In] *Kimberly-Clark [Corp. v. Johnson & Johnson]*, 745 F.2d 1437, 223 USPQ 603 (Fed. Cir. 1984) ], not only did we "fail to find a clear suggestion of the claimed subject matter," ... we found "not the slightest suggestion" in the art of the claimed dual function adhesive....

As to whether "clear suggestion" is a proper test of obviousness, we note initially that *Kimberly-Clark* is not the only instance in which we have made use of that phrase in a discussion of obviousness. Various other formulations of the requisite level of suggestion for combining prior art disclosures have been set forth in our precedent.

We need not decide here whether "clear suggestion" is an overly rigorous test for obviousness, however... . [T]his court independently reviews obviousness determinations. In reaching our own conclusion regarding

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obviousness, we need not give deference to a particular analytical construct utilized in a district court's opinion. Our task is to review the district court's judgment." 16 USPQ2d at 1926-27.

In *In re Oetiker* 24 USPQ2d 1443 (Fed. Cir. 1992), the court reiterated that "[t]here must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination" and "[t]hat knowledge can not come from the applicant's invention itself." 24 USPQ2d at 1446

Accordingly, since the Examiner has failed to state a *prima facie* case of obviousness of the pending claims and has failed to show a "clear suggestion" in the prior art itself for combining the art to render obvious applicant's claimed combination, Applicants submit that the rejections of the pending claims are improper and should be withdrawn.

#### CONCLUSION

In view of the foregoing remarks, Applicants submit that all of the pending claims are in condition for allowance and request early and favorable action on the merits. Applicants also respectfully submit that the finality of the present Office Action is improper because the Examiner has failed to make a proper

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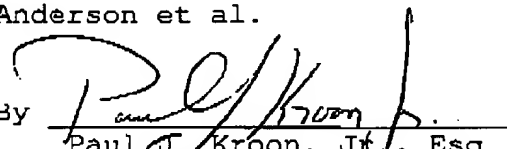
rejection of any of the pending claims.

The Examiner is invited to telephone the undersigned, Applicants' Attorney of Record, to facilitate advancement of the present application.

Respectfully submitted,

Anderson et al.

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